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PATENT
Customer No. 22,852
Attorney Docket No. 06502.0343-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Praveena VARADARAJAN et al.

Application No.: 09/885,978

Filed: June 22, 2001

For: METHOD AND SYSTEM FOR HOSTING OF
MULTIPLE BILLERS IN AN INTERNET BILL
PRESENTMENT AND PAYMENT
ENVIRONMENT

Group Art Unit: 3627

Examiner: J. Fischetti

Commissioner for Patents
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Sir:

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RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated February 10, 2004, the Examiner required restriction under 35 U.S.C. § 121 between claims 1-5 (Group I), 6 and 7 (Group II), 8-11 (Group III), 12-16 (Group IV), 17 and 18 (Group V), 19 (Group VI), and 20 (Group VII).

Applicants provisionally elect to prosecute Group I, claims 1-5 with traverse.

I. The Combination has Similar Utility as the Proposed Subcombinations

To show distinctness, the Examiner asserts that the subcombinations are separable usable because the "inventions I-VII each has separate utility such as in a word processing application." See Restriction Requirement, page 2, lines 18-19.

Applicants traverse the Examiner's position for the following reasons.

According to M.P.E.P. § 806.05(d), the Examiner “must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” And, the “burden is on the examiner to provide an example” of the divergent utilities. Using one or more of the proposed subcombinations in a “word processing application” is insufficient evidence to meet this burden. Indeed, it is unclear how using any of the subcombinations in a “word processing application” proves separate utility than the combination because, as described below, the subcombinations are all directed to a single invention; methods, articles of manufacture, and systems for retrieving and presenting billing data.

Also, the Examiner’s exemplary utility is so broad as to encompass many types of systems and processes that may be implemented by the various embodiments of the present invention. Nonetheless, the Examiner’s hypothetical subcombination utility applies to the very combination the Examiner is attempting to distinguish. That is, using the Examiner’s hypothetical utility, the asserted combination may also be used with “word processing applications” provided such applications are associated with the IBPP processes disclosed in Applicants’ specification. In fact, the flaw in the Examiner’s position is clearly shown by comparing the inventions recited in claim 1, included in Group I, and claim 12, which the Examiner has placed in Group 12. Both claims recite a method comprising the steps of “executing a single instance of a bill presentment and payment application, receiving at least one request from a customer, the request identifying a first billing entity and a second billing entity, and in response to the request, separately retrieving and presenting to the customer stored billing data associated with each of the first billing entity and the second billing entity ...”

Even broader, each of the independent claims included in the Examiner's proposed groupings include similar recitations directed to method steps or elements for retrieving and presenting to a customer stored billing data. See claim 1, lines 6-7, claim 6, lines 5-6, claim 8, lines 5-6, claim 12, lines 6-7, claim 17, lines 5-6, and claim 20, lines 5-9. Claim 19 further includes similar recitations associated with sending and receiving billing data.

Applicants are entitled to draft claims commensurate with the various scopes of the Applicants' invention. In doing so, Applicants are allowed to present their claims in different categories, such as a method, a system, and articles of manufacture. The Examiner inappropriately confuses these categories as distinct inventions, which is improper and unreasonable. In fact, it is unclear to Applicants how the Examiner finds distinctness **between claims that include the same method steps and/or elements for performing functions similar to these steps.**

II. The Asserted Groupings are not Divergent Classified Subject Matter

The Examiner attempts to show distinctness by asserting that Groups I-VII have separate utility and that they are directed to subject matter classified in divergent classes/subclass combinations. Applicants disagrees.

In reaching the conclusion, the Examiner appears to read just the preamble of the independent claims of the application, without considering the recitations in the body of these claims. For example, the Examiner has identified Group I as directed to "a billing," which is the exact language included in the preamble of claim 1, and identified Group IV as directed to "a storage medium," which is merely the category of claim 12,

i.e., a computer-readable medium. The Examiner, however, cannot merely look at the preamble; he must consider the scope of the subject matter defined by the body of each respective claim when classifying claims. When properly considered, claims 1-5 are not distinct from any combination of claims 6-20.

For instance, the Examiner asserts that Group II is distinct from Group I because the latter is directed to a “method of presentment.” If this is the case, a proper review of claim 1 shows that the claim is also directed to presentment methods. See claim 1, lines 6-7 (*i.e.*, “separately **retrieving and presenting to the customer stored billing data**”). Moreover, construing these claims in vice versa fashion, the Examiner asserts Group I is distinct from Group II because Group I is drawn to a billing method. If this is the case, a proper review of claim 6 shows that it is drawn to a similar invention (*i.e.*, executing a single instance of a bill presentment and payment application to **retrieve and present to a customer stored billing data**”).

Accordingly, it is clear that the Examiner’s asserted groupings between claims 1-5 and 6-7, for example, are unsupported by proper evaluation of the claim’s recitations, and should be withdrawn. The same problem may be found with Groups III-VII. For example, the Examiner asserts that Group III is distinct from Group I because the latter is directed to a “computer with module.” Yet, a proper review of claim 8 shows that the module(s) referred to by the Examiner are for “executing a single instance of a bill presentment and payment application” and for “**retrieving and presenting to a customer stored billing data**,” which are recitations found in claims 1 (*i.e.*, Group I) and claim 6 (*i.e.*, Group II).

Additionally, the Examiner attempts to show distinctness by classifying each group in different class/subclasses. These classifications are improper and inconsistent.

The Examiner has classified claims that include identical recitations in different subclasses. For example, claim 1 is classified in class 705, subclass 34, while its counterpart computer-readable medium claim 12 is classified in class 309, subclass 131. The Examiner's classifications are clearly incorrect and are an indication of the inconsistent reasoning for restricting claims 1-20. The same inconsistencies can be found for claim 6 and method claim 17, which are classified in class 705, subclass 40, and class 705, subclass 78. A review of these claims show that they (inadvertently) are identical claims. Applicants concede that claim 17 should have been drafted as the counterpart computer-readable medium claim of claim 6. Nonetheless, Applicants inadvertent error demonstrates the inappropriateness of the Examiner's position in restricting claims 1-20. In light of the above, Applicants invite the Examiner to demonstrate the distinctiveness of claims 6 and 17. Applicants submit that the inconsistency in these groupings and classifications cannot be reconciled

Further, the Examiner asserts that each of the groups are classified in various classes and subclasses. As explained, claims 1-20 are all directed to a single invention with varying scopes. Any attempts to classify the claims in different subclasses is improper. For example, the Examiner classifies claims 1-5 (i.e., Group I) in class 705, subclass 34. At the same time, the Examiner classifies claims 12-16 in class 309, subclass 131. As explained, claim 12 is a computer-readable medium claim corresponding to method claim 1. This inconsistency also cannot be reconciled.

Also, the Examiner's classifications are improper. For instance, the Examiner classification of Group IV in class 360, subclass 131 is arbitrary and capricious. This subclass is directed to dynamic information storage or retrieval systems and methods. Indeed, the Manual of Classification states:

[t]his class [360] is an integral part of Class 369, Dynamic Information Storage or Retrieval, following subclass 18 and is the specific class for apparatus and corresponding processes for the storage and retrieval of information based on relative movement between a magnetic record carrier and a transducer.

This class also includes apparatus and corresponding processes for making copies or editing of records falling within the above definition.

A magnetic record carrier within the meaning of this class is an element which consists of a magnetizable material or is comprised of a coating or impregnation of magnetizable material which is intended for the storage of more than a single bit of information. Storage elements which include discrete magnetic areas, inserts, spots, etc. each intended for the storage of single bits of information, whether or not relative motion is used in transducing that information, are not included in the above definition. See elsewhere for the use of such elements See Manual of Classification, Class 360.

Further, The Manual of Classification defines class 360, subclass 131 as including:

subject matter including specific structure of a record carrier.

(1) Note. Magnetic records which are defined only by their composition are not classified in this subclass. Magnetic records which include no more structure than a base having one or more coatings thereon are also excluded from this subclass. Merely naming the record as a wire, filament, rod, ribbon, strand, or record will not be sufficient to classify the patent in Class 360. For magnetic records and analogous articles which are defined only by their composition or which include no more structure than a base having one or more coatings thereon.

Nowhere has Applicants claimed or sought protection for information storage or retrieval systems, as defined by class 360, much less a more narrow aspect of these systems as defined in subclass 131. Indeed, Applicants present claim 12 as a

computer-readable medium claim including instructions for performing a billing method including steps identical to those recited in claim 1.

Another example of the inappropriateness of the proposed restriction is found in the Examiner's classification of Groups III and VII in class 709, subclasses 223 and 400, respectively. The Manual of Classification states:

[t]his class [709] provides for an electrical computer or digital data processing system or corresponding data processing method including apparatus or steps for transferring data or instruction information between a plurality of computers wherein the computers employ the data or instructions before or after transferring and the employing affects said transfer of data or instruction information.

This class also provides for the synchronization of plural processors.

The class includes the following subject matter:

A. Process or apparatus for transferring data among a plurality of spatially distributed (i.e. situated at plural locations) computers or digital data processing systems via one or more communications media (e.g., computer networks).

B. Process or apparatus for synchronizing control or regulation of clocking or timing operations of two or more processors.

SCOPE OF THE CLASS

This class is limited to digital data processing systems and functions for transferring unspecified data or instruction information and the processing thereof by digital data processing systems.

Further, The Manual of Classification defines class 709, subclass 223 as including:

subject matter further comprising means or steps for managing the resources of the computers connected by a computer network or of the network itself.

Also, class 709, subclass 400 is defined as including:

subject matter comprising means or steps for synchronizing the control or regulation of clocking or timing operations of two or more processors.

(1) Note. Classification herein is proper if a single clock or timing circuit controls the processors, plural clocks or timing circuits are synchronized to control the processors, or operations are synchronized to occur on the same clocking or timing cycle.

A proper review of claims 8-11 and 20 shows that Applicants are not seeking protection for managing the resources of the computers connected by a computer network or synchronizing the control or regulation of clocking or timing operations of two or more processors. Instead, claims 8-11 recite a billing system that includes modules for performing functions related to certain aspects of the present invention, such as retrieving and presenting to a customer stored billing data. Following the Examiner's reasoning, an applicant is subject to restriction each time they attempt to draft a system claim including elements that perform functions similar to steps recited in a corresponding method claim. Such reasoning is improper.

III. Conclusion

Applicants are not required to draft each claim with identical terms and phrases to avoid a restriction. A proper review of claims 1-20 shows that these claims are directed to a single invention with varying scopes. Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction of claims 1-20 as proposed in the Office Action dated February 10, 2004 and continue the examination of these claims as a single invention.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 9, 2004

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